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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,917	02/14/2002	Thomas Thoroe Scherb	P21821	6255

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EXAMINER

HASTINGS, KAREN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/073917

Applicant(s)

Scherb et al

Examiner

HASTINGS

Group Art Unit

1731

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on NOV 4, 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 9-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 9-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

*Claims 9, 10 and 12 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Laapotti '820.*

Laapotti '820 is applied as set forth in the last Office action on pages 3 and 4. In addition with respect to new claim 12, Laapotti also teaches a dryer cylinder 10.

Note that Laapotti at column 3 lines 50-63 teaches that after the compression pressure in the extended nip press, when one intensifies the pressure to a peak value, that pressure is intensified to a peak value approximately one order higher than the pressure applied in the preceding step. On line 12 of Laapotti '820 he teaches that the first level of compression is within the range .1 to 5 MPa. Thus if one had the first compression pressure within the range of .1 MPa, the low end of the chart range, a peak pressure approximately ~~one order higher~~ would clearly encompass a pressure of 1 MPa and certainly something less than 2 MPa. Thus within the teachings of Laapotti '820, it is contemplated that the dewatering pressure on the entire cylinder could be at most 2 MPa as recited in these claims.

Furthermore, the claims recite "comprising" and do not clearly even distinguish over having a subsequent pressing pressure that may be more than 2 MPa especially in light of the

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specification which clearly teaches, for example only on page 7, that further pressing gaps may be used at the drying cylinder.

**Claim 10 is also rejected under 35 U.S.C. § 103(a)** as being unpatentable over Laapotti '820.

Laapotti '820 is applied as in the last Office action on page 4.

**Claims 9, 10, 12 and 13 are rejected under 35 U.S.C. § 103(a)** as being unpatentable over Laapotti '046 with Laapotti '820.

Laapotti '046 teaches a drying cylinder 10 opposite an extended nip press glide shoe. Laapotti '046 is silent as to the pressure applied and the time duration. However it clearly would have been within the ordinary skill of the art to operate the extended press nip of Laapotti '046 at any pressure <sup>and time duration, as these are</sup> ~~as this is a~~ well known result effective variable for pressing paper webs. As needed, Laapotti '820 is applied as it teaches that dewatering pressures of at most 2 MPa and time durations of at least 3.5 milliseconds are known for an extended nip press against a dewatering cylinder. Thus to have used such known operating parameters for the extended nip press in Laapotti '046 would have been prima facie obvious to one of ordinary skill in the art.

**Claim 11 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Laapotti '820 or Laapotti '046 with Laapotti

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'820 as applied to claim 9 above, and further in view of Eber et al.

Eber et al. is applied as set forth in the last Office action on page 5.

**Claims 9, 10, 12 and 13 are rejected under 35 U.S.C. § 103(a)** as being unpatentable over Schiel '429 as needed with Laapotti '820.

Schiel '429 and Laapotti '820 are applied for the same reasons set forth on pages 5 and 6 of the last Office action.

Applicants' claims each recite on line 1 "a process . . . comprising" and thus are clearly open to additional pressing and press nips despite applicants' arguments to the contrary. Furthermore no criticality can be seen for having only one press nip since applicants' specification itself teaches that at least two pressing gaps may be provided at the drying cylinder and additional pressing gaps may be provided ahead of the drying cylinder.

In addition, to eliminate a press gap and its function (i.e. to eliminate the prepress gap in Schiel 429 and rely on the main press gap as rendering these claims prima facie obvious for reason set forth below) would have been prima facie obvious to one of ordinary skill in the art if one did not need additional pressing in order to adequately dewater a particular paper web.

Thus it is seen that claims 9, 10 and new claims 12 and 13 are unpatentable over the teachings of Schiel '429. It is also noted that for claim 12 in particular and in claim 12 the cylinder 38 in the first press gap reads on "a drying cylinder" absent more structural definition of what is meant by "a drying cylinder" but in any event as needed, these claims can also read on the press nip provided with the drying cylinder 60 of Schiel '429. Even though Schiel '429 teaches that it is particularly advantageous for this nip to have a maximal pressure of 2.5 MPa, this clearly is teaching a specific preferred embodiment and the reference is still open to other embodiments such as pressing below 2.5 MPa. Clearly one of ordinary skill in the art knows that pressure in a press nip is a known result effective variable and to optimize the pressure for certain situations to be at most 2 MPa as recited in these claims would have been prima facie obvious to one of ordinary skill in the art. Reference is made to reasoning and case law set forth in the rejections made in copending parent application 09/471,369 re: a) a reference made be relied upon for its nonpreferred embodiments, b) optimizing result effective variables is prima facie obvious, etc.

**Claim 11 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Schiel '429 with Laapotti '820 as applied to claim 9 above, and further in view of Eber et al.

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Eber et al. is cited is cited for the same reasons set forth on page 6 of the last Office action.

***Applicants' arguments filed November 2002 have been fully considered*** but they are not deemed to be persuasive.

Applicants' argument is that Laapotti '820 does not teach or suggest pressing the web at a pressing pressure of at most 2 MPa. The Examiner does not agree for the reasons set forth above; furthermore the claims recite "comprising" and are open to further pressing. But again as set forth above, even with further pressing, the overall teachings of Laapotti '820 still would lead one of ordinary skill in the art to operate a press with a maximum pressure of 2 MPa even with the two press nips shown in Laapotti 820 at Figures 1, 1A, 3, 3A for example. Furthermore, optimizing result effective variable such as pressure would have been within the ordinary level of skill in the art, absent evidence of unexpected results.

Furthermore Laapotti '046 is now cited as a primary reference that clearly shows only one press nip against a drying cylinder and to optimize the pressure and time would have been within the ordinary level of skill in the art, especially in view of paraments taught for extended shoe press in Laapotti 820.

Applicants' argument that Schiel operates the main press at a range of 2.5 to 5 MPa is not persuasive. First of all, the claims recite "comprising" and do not preclude a prepress and a

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main press. But even if they did, eliminating for example the prepress would have been in the ordinary level of skill in the art and operating the main press at a non-preferred maximum pressure of 2 MPa would have been within the ordinary skill in the art since pressure is a well known result effective variable and to operate a press at any pressure would have been within the ordinary level of skill in the art absent any evidence of unexpected results from operating at a specific pressure.

***Applicants' amendment necessitated the new grounds of rejection.*** Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE



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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

*Any inquiry concerning this communication* or earlier communications from the examiner should be directed to Examiner Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
Karen M. Hastings  
Senior Primary Examiner  
Art Unit 1731

KMH/cdc  
January 10, 2003

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